

May 4, 2005
Case No. AUS920010283US1(9000/37)
Serial No.: 09/864,120
Filed: May 24, 2001
Page 2 of 6

-- REMARKS --

Claims 1-30 remain under consideration. Applicants thank the Examiner and his Primary for the many courtesies extended during the April 19, 2005 interview, and regret that no agreement was reached.

A. Claims 6-9, 16-19, and 26-29 were rejected as anticipated by Davis

The rejection of claims 6-9, 16-19, and 26-29 as anticipated under 35 U.S.C §102(e) over Davis is traversed. In order to maintain this §102(e) rejection, each and every element of the claimed invention must be disclosed in as great detail by the reference. Because the reference does not disclose each and every element, this rejection must fall.

At a minimum, Davis does not disclose a "master text file" and thus Davis does not disclose "importing a translated text file corresponding to the master text file." As defined in the specification, a "master text file" is a file that "serves as a basis for multiple translation of the source language text phrases therein." *Specification of United States Patent Application, 09/864,120*, page 1, lines 21-22. In contrast, Davis merely discloses source elements 86 from a source file 24. *Abstract, Davis*. A "source file 24 includes a plurality of source elements that define operations of a source device." *Davis*, column 4, lines 15-19. "The source elements include source instructions, comments, directives, and the like. An instruction is an atomic command capable of being executed on a processing device...[including] an opcode... and operands." *Davis*, column 4, lines 19-30.

Therefore, Davis cannot anticipate independent claims 6, 16, and 26, nor claims 7-9, 17-19, and 27-29 depending from claims 6, 16, or 26 respectively. Withdrawal of the rejections to claims 6-9, 16-19, and 26-29 is requested.

May 4, 2005
Case No. AUS920010283US1(9000/37)
Serial No.: 09/864,120
Filed: May 24, 2001
Page 3 of 6

B. Claims 1, 11, and 21 were rejected as unpatentable over Davis in view of Elsbree

The rejection of claims 1, 11, and 21 as unpatentable is traversed. In order to maintain this rejection, each and every element of the claims must be taught or suggested by the references, alone or in combination; there must be a motivation to combine the references; and the references must be analogous art.

First, Davis and Elsbree are not analogous art. A review of the references indicates that Davis and Elsbree do not even share PTO classification, much less areas of search. Indeed, courts have found that such disjoint is evidence that the references are nonanalogous. Additionally, however, the similarities and differences in structure and function of the inventions rebut any allegation that the references are analogous art. Elsbree directs its attention to maintenance of code knowledge for up-to-date access thereof, while Davis is concerned with a method and apparatus for translating between source and target code. Conversely, the instant claims are directed to managing a translation of a master text file. Both Davis and Elsbree are directed to translating code between source code and machine executable code, instead of a method and system for translation management of a source language *text phrase*. Those of ordinary skill in the art readily recognize the differences between *machine executable program code* and *text phrases*. Because the references are non-analogous art, combining their teachings is improper and cannot support a §103(a) rejection.

May 4, 2005
Case No. AUS920010283US1(9000/37)
Serial No.: 09/864,120
Filed: May 24, 2001
Page 4 of 6

Furthermore, however, there is no motivation to combine the references taught by Davis in view of Elsbree, rendering the Examiner's rejection flawed for another reason. While such motivation may be express or implicit, there is no express teaching to combine in this case. Therefore, the Examiner must be relying on an implicit rationale, but makes no evidentiary showing of any such motivation. Merely arguing that a combination would "have been obvious..." (2/10/05 Office Action, p. 5, para. 7) fails to satisfy the strictures of §103. First, the Examiner makes no showing of the level of skill possessed by one of ordinary skill in the art, and further, the Examiner makes no showing that the Examiner is relying on common knowledge. See MPEP §§2144 and 2144.03. There is no suggestion, express or implied, in the prior art to make such a combination.

Even assuming that the references teach each element of the claimed invention, the prior art must suggest the desirability of the claimed invention – without a motivation to combine, a rejection based on a *prima facie* case of obviousness is improper. *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998). MPEP §2143.01. There are *only* three sources for such a motivation – the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *Id.* In this case, as the prior art does not teach the desirability of a combination, the Examiner has relied on a statement that "it would have been obvious" and so appears to be relying on either the nature of the problem or the knowledge of persons of ordinary skill in the art. However, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999) and MPEP §2143.01. And, since the Examiner does not identify the nature of the problem to be solved, the Examiner has no support for this §103(a) rejection. The conclusory statement that "providing an accurate up-to-date translation" merely identifies an impermissible hindsight motivation that cannot withstand scrutiny.

Withdrawal of the rejections to claims 1, 11, and 21 is requested.

May 4, 2005
Case No. AUS920010283US1(9000/37)
Serial No.: 09/864,120
Filed: May 24, 2001
Page 5 of 6

C. Claims 2-4, 12-14, and 22-24 were rejected as unpatentable over Davis in view of Elsbree and further in view of McKeeman

The rejection of claims 2-4, 12-14, and 22-24 as unpatentable is traversed. In order to maintain this rejection, each and every element of the claims must be taught or suggested by the references, alone or in combination; there must be a motivation to combine the references; and the references must be analogous art.

Additionally, claims 2-4, 12-14, and 22-24 depend directly or indirectly from claims 1, 11, or 21, and are therefore patentable over Davis in view of Elsbree in view of McKeeman for at least the same reasons as above.

Withdrawal of the rejections to claims 2-4, 12-14, and 22-24 is requested.

D. Claims 5, 15, and 25 were rejected without statutory citation

The rejection of claims 5, 15, and 25 is traversed. Claims 5, 15, and 25 depend from claims 1, 11, or 21, respectively, and are therefore patentable over the prior art for at least the same reasons.

Withdrawal of the rejections to claims 5, 15, and 25 is requested.

E. Claims 10, 20, and 30 were rejected as unpatentable over Davis

The rejection of claims 10, 20, and 30 is traversed. Claims 10, 20, and 30 depend from claims 6, 16, or 21, respectively, and are therefore patentable over the prior art for at least the same reasons.

Withdrawal of the rejections to claims 5, 15, and 25 is requested.

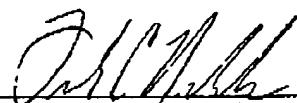
May 4, 2005
Case No. AUS920010283US1(9000/37)
Serial No.: 09/864,120
Filed: May 24, 2001
Page 6 of 6

CONCLUSION

The Applicants respectfully submit that claims 1-30 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: May 4, 2005

Respectfully submitted,
KEVIN R. HOLUBAR, *et al.*



Frank C. Nicholas
Registration No. 33,983
Attorney for Applicants

CARDINAL LAW GROUP
Suite 2000
1603 Orrington Avenue
Evanston, Illinois 60201
Phone: (847) 905-7111
Fax: (847) 905-7113